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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,986	09/26/2000	Henning Vollert	02481.1699	3891

22852 7590 02/11/2004

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
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WASHINGTON, DC 20005

EXAMINER

HANDY, DWAYNE K

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/646,986

Applicant(s)

VOLLERT, HENNING

Examiner

Dwayne K Handy

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claims 5-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pham et al. (6,171,780). The Examiner believes that applicant is familiar with the reference "Pham" as it has been applied to the claims as a 102 reference in previous rejections. In light of its use as a 103 reference, however, the Examiner will repeat the teachings of Pham. Pham teaches a low fluorescence platform which contains a large number of miniaturized wells for assaying compounds. The platform is best shown in Figures 1 and 2, and described in columns 10-15. The platform is provided in a standard microtitre plate footprint (col. 10, 1. 32) and may contain any number of wells from about 50 to 10,000. Preferably, the number of wells is a multiple of 96 and may include the commonly used number of 1536 wells. Materials of construction are

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disclosed in column 10, lines 5-20 and columns 15-16. The frame may be made of "any material, such as polymers, such as polystyrene or cycloolefins, or other materials, such as glass or quartz" (col. 10, 1. 13). The base is described as typically polymeric...however, other materials can be used to make the frame or bottom of the multi-well platform, such as glass or quartz. The frame and bottom can be made of the same or different materials and the bottom can comprise polystyrene or another material (col. 15, 1. 30)". Continuing in column 15: For example the frame and bottom can be made as one discrete piece. Alternatively, the frame can be one discrete piece, and the bottom can be a second discrete piece which are combined to form a multiwell platform....For example, the frame can be made of a polymer, and the bottom made of polystyrene, glass, or quartz (col. 15, 1. 45). As to the dimensions of the base and wells, Pham recites diameters for the wells of about 0.2 to 50 millimeters (col. 13, 1. 4) and a thickness for the base of about 10-1000 micrometers (col. 13, 1. 60). Pham teaches wells coating for both suppression and encouraging material binding in the wells in column 15, lines 3-29. Therefore, Pham teaches every element of applicant's device except for the edge distance. Pham does not specifically recite the limitation of "the distance between the center and outer vessels and an edge of the glass bas ranges from 4-11 mm. Pham does show embodiments (Figure 2) which provides an edge

It would have been obvious to one of ordinary skill in the art, then, to provide a distance between the outer vessels of the base and the edge of the base in the range of 4-11 mm for several reasons. One, this would provide room for handling the plate by either manual or automated means. Also, this would provide a border area which could be

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used to prevent material from spilling over the edge of the base if material is spilled from the wells. Finally, this would allow for an area surrounding the wells that could be used for stacking plates on top of one another without disturbing the contents of the wells.

Response to Arguments


3. Applicant's arguments, filed 11/12/2003, with respect to the rejection(s) of claim(s) 5-14 under 102 using the reference "Pham" have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Pham under a 103 rejection. Applicant's arguments in the Appeal Brief directed to the Examiner's "picking and choosing" (Examiner's term) of certain ranges from the reference Pham are duly noted and provide the basis for the Examiner lifting the 102 rejections. In particular, the Examiner notes applicant's citing of the fact that inherency may not be established by probabilities or possibilities (page 8, Section C) and also applicant's citing of ranges that are not disclosed with "sufficient specificity" (page 6, Section B). Based on these passages/arguments, the Examiner concurs that a 102 rejection using the reference Pham was improper.

The Examiner would also like to remind applicant that if applicant wishes to later argue that the specific ranges are unique and non-obvious due to the specific ranges leading to improved confocal analysis (also page 6, Section B), then applicant should also submit evidence backing this claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267.

DKH
February 9, 2004


Jill Warden
Supervisory Patent Examiner
Technology Center 1700